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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/565,159	01/19/2006	Milan Kacavenda	APV31917	9031

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EXAMINER

DANG, HUNG XUAN

ART UNIT	PAPER NUMBER
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2873

DATE MAILED: 11/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/565,159	KACAVENDA, MILAN	
	Examiner	Art Unit	
	Hung X. Dang	2873	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1,5-11,14 and 16-18 is/are rejected.
- 7) ☒ Claim(s) 2-4,12,13 and 15 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

Information Disclosure Statement

1. The prior art documents submitted by applicant in the Information disclosure Statements filed on 1/19/06 has all been considered and made of record (noted attached copy of form PTO-1449).

Claims Rejection Under 35 USC – 112-1st Paragraph

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 16 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no where in the specification described "wherein said hook element is insertable with play into seating to allow a pre-determined vertical movement of the temples, and also a possible pantoscopic adjustment, by means of a prior conformation of said endpiece" as recited in claim16.

Claims Rejection Under 35 USC - 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 5-8, 14, 17 and 18 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by **Drlik** (4,747,183).

Drlik discloses temple biasing eyeglass spring hinge comprises a male hinge element pivoted to a female element, wherein the male hinge element comprising a tie rod 3a able to slide with respect to the temple 6, a bushing 7 arranged inside the temple 6 and axially associated with the tie rod 3a and a spring 4 loaded between the bushing 7 and an abutment element 36 attached to the tie rod 3a, wherein the female element comprising a seat 1, the male hinge element comprising a hook 2 solid with the tie rod 3a, housed in the seat and able to articulate on a pin 13 arranged inside the seating and bushing 7 is clamped through interference inside a mate hole 5 made in the temple 6, wherein the seat 1 having two fins (no reference) (see figures 1-5 and the related disclosure.)

Claim 1, line 14, the term "by removing material" is considered to be a step in a manufacturing method and is therefore considered not having a limiting effect on the apparatus claimed by claim 1.

Claims Rejection Under 35 USC - 102

4. Claims 1, 5-8, 14, 17 and 18 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by **Lo** (6,353,965).

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Lo discloses hinge of eyeglass frame comprises a male hinge element pivoted to a female element, wherein the male hinge element comprising a tie rod 10a able to slide with respect to the temple 50, a bushing 20 arranged inside the temple 50 and axially associated with the tie rod 10a and a spring 30 loaded between the bushing 20 and an abutment element 40 attached to the tie rod 10a, wherein the female element comprising a seat 70, the male hinge element comprising a hook 10d solid with the tie rod 10a, housed in the seat and able to articulate on a pin 60 arranged inside the seating and bushing 20 is clamped through interference inside a mate hole made in the temple 50, wherein the seat 70 having two fins (no reference) (see figures 2-7 and the related disclosure.)

Claim 1, line 14, the term "by removing material" is considered to be a step in a manufacturing method and is therefore considered not having a limiting effect on the apparatus claimed by claim 1.

Claims Rejection Under 35 USC - 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Drlik** (4,747,183).

Drlik discloses temple biasing eyeglass spring hinge comprises a male hinge element pivoted to a female element, wherein the male hinge element comprising a tie rod 3a able to slide with respect to the temple 6, a bushing 7 arranged inside the temple 6 and axially associated with the tie rod 3a and a spring 4 loaded between the bushing 7 and an abutment element 36 attached to the tie rod 3a, wherein the female element comprising a seat 1, the male hinge element comprising a hook 2 solid with the tie rod 3a, housed in the seat and able to articulate on a pin 13 arranged inside the seating and bushing 7 is clamped through interference inside a mate hole 5 made in the temple 6, wherein the seat 1 having two fins (no reference) (see figures 1-5 and the related disclosure.)

Drlik does not teach the bushing shape-line a truncated cone (claim 9) and one end of the bushing having a reduced diameter (claim10).

Although the Drlik device does not teach the exact shape of the bushing as that claimed by Applicant, the shape differences are considered obvious design choices and are not patentable unless unobvious or unexpected results are obtained from these changes. Additionally, the Applicant has presented no discussion in the specification which convinces the Examiner that the particular shape of the support means is anything more than one of numerous shapes a person of ordinary skill in the art would find obvious for the purpose of providing support. *In re Dailey*, 149 USPQ 47 (CCPA

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1976). It appears that these changes produce no functional differences and therefore would have been obvious.

Claims Rejection Under 35 USC - 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Claims 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lo (6,353,965).

Lo discloses temple biasing eyeglass spring hinge comprises a male hinge element pivoted to a female element, wherein the male hinge element comprising a tie rod 3a able to slide with respect to the temple 6, a bushing 7 arranged inside the temple 6 and axially associated with the tie rod 3a and a spring 4 loaded between the bushing 7 and an abutment element 36 attached to the tie rod 3a, wherein the female element comprising a seat 1, the male hinge element comprising a hook 2 solid with the tie rod 3a, housed in the seat and able to articulate on a pin 13 arranged inside the seating and bushing 7 is clamped through interference inside a mate hole 5 made in the temple 6, wherein the seat 1 having two fins (no reference) (see figures 1-5 and the related disclosure.)

Lo does not teach the bushing shape-line a truncated cone (claim 9) and one end of the bushing having a reduced diameter (claim 10).

Although the Lo device does not teach the exact shape of the bushing as that claimed by Applicant, the shape differences are considered obvious design choices and

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are not patentable unless unobvious or unexpected results are obtained from these changes. Additionally, the Applicant has presented no discussion in the specification which convinces the Examiner that the particular shape of the support means is anything more than one of numerous shapes a person of ordinary skill in the art would find obvious for the purpose of providing support. *In re Dailey*, 149 USPQ 47 (CCPA 1976). It appears that these changes produce no functional differences and therefore would have been obvious.

Allowable Subject Matter

7. Claims 2-4 and 12, 13 and 15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Reasons For Allowance

8. The following is an Examiner's Statement of Reasons for Allowance:

There was no prior art found by the examiner that suggested modification or combination with the cited prior art so as to satisfy the combination of the present dependent claim 2; especially, the prior art does teach the male hinge element comprising two tie rods arranged co-planar and substantially parallel with each other, and able to be pivoted with the relative hook elements inside relative seatings as recited in claim 2.

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There was no prior art found by the examiner that suggested modification or combination with the cited prior art so as to satisfy the combination of the present dependent claim 3; especially, the prior art does teach the male hinge element comprising two tie rods arranged co-planar and substantially parallel with each other, and able to be pivoted with the relative hook elements inside a single seating as recited claim 3.

Art Pertinent

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure Tabacchi (6,910,247) teach hinge for eyeglass which is considered pertinent to the claimed invention.
10. Any inquiry concerning this communication should be directed to Examiner Dang at telephone number (571) 272-2326.

10/06



HUNG DANG

PRIMARY EXAMINER

TC 2800